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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Adam J. Katz et al.
Serial No.: 09/936,665
Filed: September 10, 2001
U.S. Patent: 6,777,231
Issued: August 17, 2004
Docket: 30448.77USW1
Title: ADIPOSE-DERIVED STEM CELLS AND LATTICES

CERTIFICATE UNDER 37 CFR §1.8

I hereby certify that this paper or fee is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on February 9, 2005.

By: Renato Marco P. Dominguez
Name: Renato Marco P. Dominguez

55 S. Lake Avenue, Suite 710
Pasadena, California 91101
February 9, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

We are transmitting herewith the attached:

- ☒ Transmittal sheet, in duplicate, containing Certificate under 37 CFR §1.8
- ☒ Communication
- ☒ Exhibit 1 – Copy of Complaint for Correction of Inventorship under 35 U.S.C. §256 filed with the District Court for the Central District of California
- ☒ Exhibit 2 – Copy of Answer to Complaint for Correction of Inventorship under 35 U.S.C. §256
- ☒ Return postcard

Please charge any fees or credit overpayment to Deposit Account No. 50-0306. A duplicate of this sheet is enclosed.

MANDEL & ADRIANO
55 S. Lake Avenue, Suite 710
Pasadena, California 91101
(626) 395-7801

By: Sarah B. Adriano
Name: Sarah B. Adriano
Reg. No.: 34,470
Customer No. 26941

BEST AVAILABLE COPY



30448.77USW1/SBA/RDG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Adam J. Katz, Ramon Llull, William J. Futrell, Marc H. Hedrick,
Prosper Benhaim, Hermann Peter Lorenz and Min Zhu

U.S. Serial No.: 09/936,665 **Examiner:** James Ketter, Ph.D.

Filed: September 10, 2001 **Group Art Unit:** 1636

U.S. Patent No.: 6,777,231

Issue Date: August 17, 2004

Title: ADIPOSE-DERIVED STEM CELLS AND LATTICES

55 So. Lake Avenue, Suite 710
Pasadena, California 91101
February 9, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

COMMUNICATION

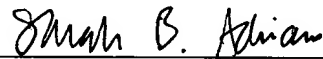
Attorneys for Applicants bring to the Office's attention that on October 29, 2004, The University of Pittsburgh filed a Complaint for Correction of Inventorship under 35 U.S.C. § 256 of the above-identified patent, against co-inventors Hedrick, Benhaim, Lorenz and Zhu, in the District Court for the Central District of California, Case No. CV-04-9014 CBM (AJWx) ("Complaint"). A copy of the Complaint is attached hereto as Exhibit 1. An Answer was filed on behalf of all four defendants on January 5, 2005, a copy of which is attached hereto as Exhibit 2.

Applicants: Adam J. Katz, et al.
U.S. Serial No: 09/936,665
Filed: September 10, 2001
Page: 2

Additionally, both the subject application, now patent, and co-pending application, U.S. Serial No. 09/947,985 were being examined by Examiner Sandals, who was the Examiner of record on both applications before his departure from the Patent Office. However, since Examiner Sandals is no longer with the Patent Office, please note that U.S. Serial No. 09/947,985 remains pending and is being prosecuted by Counsel of The University of Pittsburgh.

No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is necessary, the Patent Office is authorized to charge any additional fee to Deposit Account No. 50-0306.

Respectfully submitted,



Sarah B. Adriano
Registration No. 34,470
SaraLynn Mandel
Registration No. 31,853
Attorneys for Applicants
Mandel & Adriano
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Pasadena, California 91101
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11/09/04 12:25 UC GENERAL COUNSEL 12 3116793226

0 002 1000 005

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14 Attorneys for Plaintiff
15 University of Pittsburgh of the
Commonwealth System of Higher Education

17 UNITED STATES DISTRICT COURT
18 CENTRAL DISTRICT OF CALIFORNIA

20 UNIVERSITY OF PITTSBURGH
OF THE COMMONWEALTH
21 SYSTEM OF HIGHER
EDUCATION.

22 Plaintiff,

23 vs.

24 MARC H. HEDRICK, PROSPER
25 BENHAIM, HERMANN PETER
LORENZ, and MIN ZHU,

26 Defendants.
27
28

1-714/2036796.2

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FILED

Case No.

CV 04-9014
COMPLAINT FOR CORRECTION
OF INVENTORSHIP UNDER 35

DOCKETED ON CM
NOV - 3 2005
BY lt 019

1 Plaintiff University of Pittsburgh of the Commonwealth System of Higher
2 Education ("Plaintiff"), by and through its undersigned counsel, brings this
3 Complaint against Defendants Marc H. Hedrick, Prosper Benhaim, Hermann Peter
4 Lorenz, and Min Zhu (collectively "Defendants") and in support thereof, avers as
5 follows:

6 Jurisdiction and Venue

7 1. Plaintiff brings this action pursuant to the Patent Laws of the United
8 States, 35 U.S.C. §§ 1 and 256.

9 2. This Court has jurisdiction over this action pursuant to 28 U.S.C. § 1331
10 (federal question jurisdiction) and § 1338(a) (original jurisdiction under patent
11 laws).

12 3. Venue is proper in this judicial district under 28 U.S.C. § 1391(b) (general
13 venue statute).

14 The Parties

15 4. Plaintiff is an assignee of U.S. Patent No. 6,777,231 ("the '231 patent"),
16 and has its principal place in Pittsburgh, Pennsylvania.

17 5. Defendant Marc H. Hedrick is identified on the '231 patent as one of
18 seven named inventors. Upon information and belief, Hedrick resides at 2345
19 Jennifer Lane in Encinitas, California.

20 6. Defendant Prosper Benhaim is identified on the '231 patent as one of
21 seven named inventors. Upon information and belief, Benhaim resides at 17018
22 Hartsook Street in Encino, California.

23 7. Defendant Hermann Peter Lorenz is identified on the '231 patent as one
24 of seven named inventors. Upon information and belief, Lorenz resides at 2634
25 Belmont Canyon Road in Belmont, California.

26 8. Defendant Min Zhu is identified on the '231 patent as one of seven named
27 inventors. Upon information and belief, Zhu resides in San Diego, California.
28

1-2K/2050796.2

Factual Background

9. On or about August 17, 2004, the U.S. Patent and Trademark Office issued the '231 patent, which is entitled "Adipose-Derived Stem Cells and Lattices." A true and correct copy of the '231 patent is attached hereto as Exhibit "A."

10. The '231 patent lists Adam J. Katz, Ramon Llull, William J. Futrell, Marc H. Hedrick, Prosper Benhaim, Hermann Peter Lorenz and Min Zhu as named inventors.

11. Inventors Katz, Llull, and Futrell assigned to Plaintiff their rights in the application, which issued as the '231 patent. The assignment is recorded in the U.S. Patent and Trademark Office records as Reel 010998 Frame 0570. A true and correct copy of the assignment is attached hereto as Exhibit "B."

12. Although the Plaintiff's name does not appear on the face of the '231 patent due to a clerical error, Plaintiff is a true and current assignee by assignment from Katz, Llull, and Futrell.

COUNT I

(Correction of Inventorship under 35 U.S.C. § 256)

13. Plaintiff incorporates by reference paragraphs 1 through 12 as though fully set forth herein.

14. The '231 patent names Adam J. Katz, Ramon Llull, William J. Futrell, Marc H. Hedrick, Prosper Benhaim, Hermann Peter Lorenz and Min Zhu as inventors.

15. Katz, Llull, and Futrell are the true and correct inventors of the claims of the '231 patent.

16. Upon information and belief, Hedrick, Benhaim, Lorenz, and Zhu are not inventors of the claimed subject matter of the '231 patent and are thus, incorrectly named as inventors.

11/09/04 10:26

UC GENERAL COUNSEL (2) + 914153932286

NO. 026 P005/025

1 WHEREFORE, Plaintiff prays for a judgment from the Court against
2 Defendants as follows:

- 3 (a) a determination of the true and correct inventorship of the '231 patent;
4 (b) a determination that Hedrick, Denham, Lorenz, and Zhu are not
5 inventors of the '231 patent; and
6 (c) such other further relief as this Court may deem just and proper.
7

8 Dated: October 29, 2004

MORGAN, LEWIS & BOCKIUS LLP

9
10 By 
11 Teresa A. MacDonald
12 Ann A. Byun
13 David W. Merston Jr.

14 UNIVERSITY OF PITTSBURGH
15 Alan A. Garfinkel

16 Attorneys for Plaintiff
17 University of Pittsburgh of the
18 Commonwealth System of Higher
19 Education
20
21
22
23
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25
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27
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1-20/1006796.2

11/09/04 10:26

UC GENERAL COUNSEL (2)

11/09/04 10:26 P006/025

Jury Trial Demand

Plaintiff University of Pittsburgh of the Commonwealth System of Higher
Education hereby demands a trial by jury on all issues properly triable by jury.

Dated: October 29, 2004

MORGAN, LEWIS & BOCKIUS LLP

By

Teresa A. MacDonald
Teresa A. MacDonald
Ann A. Byun
David W. Marston Jr.

UNIVERSITY OF PITTSBURGH
Alan A. Garfinkel

Attorneys for Plaintiff
University of Pittsburgh of the
Commonwealth System of Higher
Education

1-FR/3086796.2

5

11/09/04 10:26

UC GENERAL COUNSEL (2) → 914153932286

NO.026 P007/025

EXHIBIT A

11/29/04 10:31 UC GENERAL COUNSEL (2) + 914153932286

NO. 026 P021/025

<div style="display: flex; justify-content: space-between;"> 1.34.00 REGISTRATION OF PATENT 05-18-2000 </div> <div style="text-align: center; font-weight: bold; font-size: 1.2em;"> INTERNATIONAL 101 REMISS </div>		U.S. Patent Office Washington, D.C. 20540-0001 (202) 512-2000
Applicant Type <input type="checkbox"/> New <input checked="" type="checkbox"/> Reexamination (Non-Prosecutable) <input type="checkbox"/> Continuation of PTO Case <input type="checkbox"/> Foreign Filing <input type="checkbox"/> Continuation (Domestic) Serial No. Filing Date		Examination Type <input type="checkbox"/> Designated <input type="checkbox"/> Utility <input type="checkbox"/> Plant <input type="checkbox"/> Chemical <input type="checkbox"/> Biotechnology <input type="checkbox"/> Other:
Conveying Party(ies) 1. Adam J. MATZ 2. George J. LILL 3. J. William RUTRELL 4. 5. 6.		Examination Date(s) April 17, 2000 April 18, 2000 April 17, 2000
<input type="checkbox"/> Mark I Additional Name(s) of Conveying Party Added		
Receiving Party Name: University of Pittsburgh of the Commonwealth System of Higher Education Address: 200 Grueter Hall Conference Center Address: Pittsburgh PA 15261 Address: City State Country Zip Code		
<input type="checkbox"/> Mark I Additional Name(s) of Receiving Party Added		
Receiving Party Name and Address M. David Hoffer, Reg. 41,628 Loyola, Vols. Meyer, Ltd. Two Parkside Plaza, Suite 4000 Chicago, Illinois 60621-4229 Telephone: (312) 618-4800 Facsimile: (312) 611-4700 Attorney Council No. 304687		
<input type="checkbox"/> Mark I Additional Name(s) of Receiving Party Added		
Receiving Party Name and Address M. David Hoffer, Reg. 41,628 Loyola, Vols. Meyer, Ltd. Two Parkside Plaza, Suite 4000 Chicago, Illinois 60621-4229 Telephone: (312) 618-4800 Facsimile: (312) 611-4700 Attorney Council No. 304687		
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Receiving Party Name and Address M. David Hoffer, Reg. 41,628 Loyola, Vols. Meyer, Ltd. Two Parkside Plaza, Suite 4000 		

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PATENT
REEL: 010906 FRAME: 0670

EXHIBIT B
PAGE 18

11/09/04 10:31 UC GENERAL COUNSEL (2) + 914153932286

NO.026 P022/025

Loydie, Velt & Meyer, Ltd.
Attorneys at Law
Two Financial Place
Suite 4000
110 North Western
Chicago, Illinois 60607-6780

Attorney Number No. 00267

ASSIGNMENT

WHEREAS, WE, Adam J. Katz, Ramon L. Hall, and J. William Petrell, of 1207 Trevanion Street, Pittsburgh, Pennsylvania 15218, Enric Gimenez, 18-4*-2*, Barcelona E-03004, Spain, and 1 Sweetwater Lane, Pittsburgh, Pennsylvania 15238, respectively, have invented and own a certain invention entitled:

ADIPOSE-DERIVED STEM CELLS AND LATTICES

for which invention we have executed a PCT patent application designating the United States and other countries worldwide, which was filed on March 10, 2000, and accorded PCT Application No. PCT/US00/06232, and

WHEREAS, University of Pittsburgh of the Commonwealth System of Higher Education, at 300 Garden Street Conference Center, Pittsburgh, Pennsylvania 15260 (hereinafter referred to as Assignee), is desirous of acquiring the entire domestic and foreign right, title, and interest in and under the invention described in the patent application.

Now, THEREFORE, for good and valuable considerations, the receipt and satisfaction of which are hereby acknowledged, we assign and transfer to the Assignee and the Assignee's legal representatives, successors and assigns the full and exclusive right in and to the invention in the United States and every foreign country and the entire right, title, and interest in and to the patent application and other such applications (e.g., provisional applications, non-provisional applications, continuations, continuations-in-part, divisionals, renewals, amendments, and extensions) that may be filed in the United States and every foreign country on the invention, and the payment or outlayments thereof, both foreign and domestic, that may issue thereon, and we do hereby authorize and request the Commissioner of Patents and Trademarks to have United States patents to the above-mentioned Assignee agreeably with the terms of this assignment document.

We HEREBY AUTHORIZE the Assignee to insert in this assignment document the filing date and serial number of the application if the date and number are unavailable at the time this document is executed.

UPON SAID CONSIDERATION, we convey to the Assignee the right to make application in its own behalf for protection of the invention in the United States and countries foreign to the United States and to claim under the International Convention and/or other international arrangements for any such application the date of the PCT application and any priority documents claimed therein (or any other application on the invention) to gain priority with respect to other applications.

WE DO HEREBY COVENANT and agree with the Assignee that we will not execute any writing or do any act whatsoever conflicting with the terms of this assignment document as set forth herein, and that we will at any time upon request, without further or additional consideration, but at the expense of the Assignee, execute such additional assignments and other

PATENT
REEL: 010863 FRAME: 0871

EXHIBIT	B
PAGE	19

11/09/04 10:32 UC GENERAL COUNSEL (2) + 914153932286

NO.026 P023/025

In re Appl. of Katz et al,
 Attorney Docket No. 254267

writings and do such additional acts as the Assignee may deem necessary or desirable to perfect the Assignee's enjoyment of this assignment, and render all necessary assistance in making application for and obtaining original, continuation, continuation-in-part, divisional, amended, renewal, or extended patents of the United States or of any and all foreign countries on the invention, and in enforcing any rights or claims in action accruing as a result of such applications or patents, and by executing statements and other affidavits, it being understood that the foregoing covenant and agreement shall bind, and have to the benefit of, the heirs and legal representatives of all parties hereto.

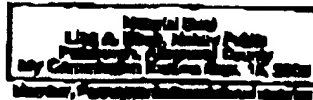
IN WITNESS WHEREOF, we have hereunder set our hands on the date shown below.

Date 4/2/05 Adam J. Katz
 STATE OF Wisconsin)
 COUNTY OF Dallas) SS:

On this 17th day of April, 2005, before me, a Notary Public in and for said county, appeared Adam J. Katz, who is personally known to me to be the same person whose name is subscribed to the foregoing assignment document, and acknowledged that he/she signed and delivered the document as his/her free and voluntary act for the uses and purposes therein set forth.

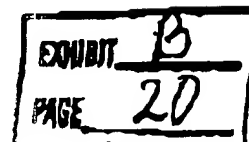
Leon A. Strub
 Notary Public
 My Commission Expires 07-15-08

(SEAL)



2

PATENT
 REEL: 010008 FRAME: 0672



In re Apple, et al.
Attorney Docket No. 206267

Date April 19, 2000

[Signature]
Bingham LLP

Date APRIL 19, 2000

Witness [Signature]

Date 8/10/2000

Witness [Signature]

3

PATENT
REEL: 010000 FRAME: 0573

EXHIBIT 13
PAGE 21

11/09/04 10:32 UC GENERAL COUNSEL (2) + 914153932286

2025/025

In re Appln. of Kyan et al.
Attorney Docket No. 204267

Date 4/7/05
STATE OF Pennsylvania
COUNTY OF Allegheny) SS:

J. William Futrell
J. William Futrell

On this 17th day of April, 2005, before me, a Notary Public in and for said county, appeared J. William Futrell, who is personally known to me to be the same person whose name is subscribed to the foregoing assignment document, and acknowledged that he/she signed and delivered the document as his/her free and voluntary act for the uses and purposes therein set forth.

[Signature]
Notary Public

(SEAL)

My Commission Expires:



RECORDED: 07/24/2000

PATENT
REEL: 010000 FILE: 0674

EXHIBIT B
PAGE 22

FILE COPY

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Attorneys for Defendants
MARC H. HEDRICK, PROSPER BENHAIM,
HERMANN PETER LORENZ, and MIN ZHU

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

UNIVERSITY OF PITTSBURGH OF
THE COMMONWEALTH SYSTEM OF
HIGHER EDUCATION,

Plaintiff,

v.

MARC H. HEDRICK, PROSPER
BENHAIM, HERMANN PETER
LORENZ, and MIN ZHU,

Defendants.

No. CV-04-9014 CBM (AJWx)

ANSWER TO COMPLAINT FOR
CORRECTION OF
INVENTORSHIP UNDER
35 U.S.C. § 256 AND DEMAND
FOR JURY TRIAL

Defendants Marc H. Hedrick, Prosper Benhaim, Hermann Peter Lorenz and Min Zhu (collectively, "Defendants") by and through their undersigned counsel, hereby file their Answer, including Affirmative Defenses, in response to the Complaint of Plaintiff University of Pittsburgh of the Commonwealth System of Higher Education ("Plaintiff") in the above-captioned action in accordance with the numbered paragraphs in the Complaint. Except to the extent expressly and specifically admitted herein, Defendants deny each and every allegation contained in the Complaint.

ANSWER TO COMPLAINT FOR CORRECTION OF INVENTORSHIP

I. ANSWER

Answering each of the corresponding numbered paragraphs of the Complaint, Defendants answer and respond to the allegations therein, based on each Defendant's current information and belief, as follows:

JURISDICTION AND VENUE

1. Defendants admit only that the Complaint purports to state a cause of action under the laws of the United States, Title 35, United States Code §§ 1 and 256.

2. Defendants admit that this Court has subject matter jurisdiction over this action pursuant to Title 28, United States Code §§ 1331 and 1338(a).

3. Defendants admit that venue is proper in this judicial district under 28 U.S.C. § 1391(b).

THE PARTIES

4. Defendants deny that Plaintiff is listed as the assignee of U.S. Patent No. 6,777,231 (the "231 Patent") on the face thereof. Defendants lack sufficient knowledge or information to form a belief as to the truth or falsity of the remaining allegations contained in paragraph 4 of the Complaint, and, on that basis, deny the allegations.

5. Defendants admit that defendant Hedrick is identified on the face of the '231 Patent as one of the seven named inventors. Defendant Hedrick admits that he resides at 2345 Jennifer Lane, Encinitas, California.

6. Defendants admit that Prosper Benhaim is identified on the face of the '231 Patent as one of the seven named inventors. Defendant Benhaim admits that he resides at 17018 Hartsook Street in Encino, California.

7. Defendants admit that Hermann Peter Lorenz is identified on the face of the '231 Patent as one of the seven named inventors. Defendant Lorenz admits that he resides at 2634 Belmont Canyon Road in Belmont, California.

1 8. Defendants admit that Min Zhu is identified on the face of the
2 '231 Patent as one of the seven named inventors. Defendant Zhu admits that she
3 resides in San Diego, California.

4 **FACTUAL BACKGROUND**

5 9. Defendants admit that the face of the '231 Patent shows that it
6 was issued on August 17, 2004 and is entitled "Adipose-Derived Stem Cells and
7 Lattices." Defendants further admit that a copy of the '231 patent is attached to the
8 Complaint as Exhibit A.

9 10. Defendants admit that the face of the '231 Patent lists Adam J.
10 Katz, Ramon Llull, William J. Futrell, Marc H. Hedrick, Prosper Benhaim,
11 Hermann Peter Lorenz and Min Zhu as inventors.

12 11. Defendants admit that Exhibit B is a copy of a document that,
13 on its face, purports to assign the interests of Adam J. Katz, Ramon Llull and J.
14 William Futrell in an invention entitled "Adipose-Derived Stem Cells and
15 Lattices" to Plaintiff. Defendants lack sufficient knowledge or information to form
16 as a belief as to the truth or falsity of the remaining allegations contained in
17 paragraph 11 of the Complaint, and, on that basis, deny the allegations.

18 12. Defendants admit that Plaintiff's name does not appear on the
19 face of the '231 patent. Defendants lack sufficient knowledge or information to
20 form as a belief as to the truth or falsity of the remaining allegations contained in
21 paragraph 12 of the Complaint, and, on that basis, deny the allegations.

22 **COUNT I**

23 13. Defendants incorporate by reference and restate their responses
24 to paragraphs 1-12 as though fully set forth herein.

25 14. Defendants admit that the face of the '231 Patent lists Adam J.
26 Katz, Ramon Llull, William J. Futrell, Marc H. Hedrick, Prosper Benhaim,
27 Hermann Peter Lorenz and Min Zhu as inventors.

15. Defendants lack sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained in paragraph 15 of the Complaint, and, on that basis, deny the allegations.

16. Defendants deny that each defendant is not an inventor of the claimed subject matter of the '231 Patent. Defendants lack sufficient knowledge or information to form as a belief as to the truth or falsity of the remaining allegations, if any, contained in paragraph 12 of the Complaint, and, on that basis, deny the allegations.

II. DEFENSES

In further answering the Complaint, Defendants plead the following defenses:

FIRST DEFENSE (FAILURE TO STATE A CLAIM)

The Complaint fails to state a claim or claims upon which relief can be granted.

WHEREFORE, Defendants respectfully request that this Court enter a judgment on the Complaint granting the relief set forth below:

a) a dismissal with prejudice of Plaintiff's Complaint as against Defendants;

b) a denial of all relief sought by Plaintiff as against Defendants;

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ANSWER TO COMPLAINT FOR CORRECTION OF INVENTORSHIP


1 c) that this Court declare that Defendants are inventors of the '231
2 Patent;

3 d) such other relief as this Court may deem just and proper.

4 DATED: January 5, 2005

5 BINGHAM MCCUTCHEN LLP
6 JAMES B. LEWIS
7 JENNIFER M. PHELPS

8
9 By


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ANSWER TO COMPLAINT FOR CORRECTION OF INVENTORSHIP

JURY DEMAND

Defendants Hedrick, Benhaim, Lorenz, and Zhu hereby demand a trial by jury on all issues on which a trial by jury may be had.

DATED: January 5, 2005

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ANSWER TO COMPLAINT FOR CORRECTION OF INVENTORSHIP

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